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In re Application of :  
HURST et al. :  
U.S. Application No. 10/566,410 :  
PCT No.: PCT/US04/017921 :  
It. Filing Date: 04 June 2004 :  
Priority Date: 30 July 2003 :  
Attorney Docket No.: PP020110000559516313 :  
For: METHODS OF THERAPY FOR :  
CHRONIC LYMPHOCYTIC LEUKEMIA :

DECISION ON PETITION

This decision is issued in response to "Petition under 37 CFR 1.47(a)" filed 21 February 2007 to accept the application without the signature of joint-inventor, Maurice Wolin.

**BACKGROUND**

On 04 June 2004, applicants filed international application PCT/US04/017921, which claimed priority of an earlier application filed 30 July 2003. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 24 February 2005. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 30 January 2006.

On 30 January 2006, applicants filed a transmittal letter for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1) and a copy of the international application.

On 21 July 2006, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 21 February 2007, applicants filed a petition under 37 CFR 1.47(a).

## DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17, (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the nonsigning joint inventor. Items (1), (3), and (4) have been satisfied.

As to item (2), it is unclear whether the petitioner is asserting that the nonsigning inventor has refused to execute the application or cannot be located to execute the application. Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47.

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included statement of facts. It is important that the statement contain facts as opposed to conclusions.

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time

and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

As to item (2), petitioner has not provided sufficient proof that the nonsigning inventor has refused to execute the application. Petitioner states that a copy of the application papers were mailed to Maurice Wolin on 16 October 2006, 29 January 2007, and 05 February 2007. However, petitioner fails to include evidence to demonstrate that the materials were actually received by the nonsigning inventor. Where the Office is being asked to accept the silence of the nonsigning inventor as evidence of a refusal to sign, petitioner must provide some evidence that the application materials have been received by the nonsigning applicant.

Further, petitioner has not provided sufficient proof that Maurice Wolin is unavailable to execute the application. Petitioner states that an internet searches were done to locate Maurice Wolin, however, no documentary evidence has been provided. As stated above, documentary evidence to show that alternative means were employed, such as a search of telephone and/or Internet directories, telegrams, etc., should be supplied by a person having firsthand knowledge of the facts. It is noted that multiple mailings to the nonsigning inventor's last known address does not constitute a "diligent" effort to locate the inventor.

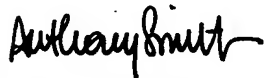
For the above reasons, it would not be appropriate to accept this application without the signature of Maurice Wolin at this time.

### **CONCLUSION**

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to: Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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